

**Track on Case Law:
judgments of the GC and decisions
of the EUIPO BoA
2021 Q2**

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PROGRAMME

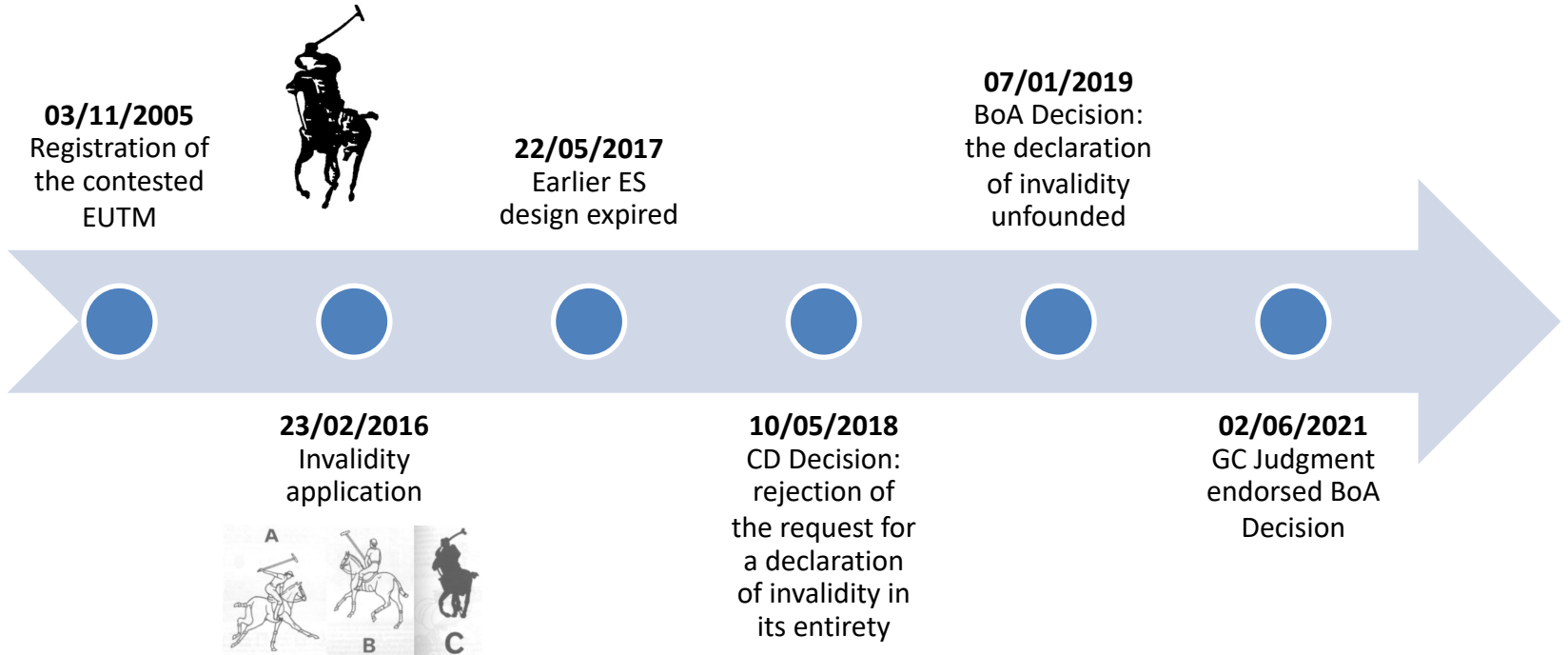
50'
Presentation

- 1) Procedural issues
- 2) Absolute grounds
- 3) Relative grounds

10'
Questions and answers

1 Procedural issues

Expiry of the earlier right during proceedings: 02/06/2021 T-169/19 Device of a polo player



Expiry of the earlier right during proceedings

From the overall scheme of the provisions on relative grounds for invalidity, an application for a declaration of invalidity should be rejected **when the conflict with the earlier mark is over** (§ 27)

Relevant point in time  end of invalidity proceedings (§ 29)

The proprietor of an earlier IP right must establish that he may prohibit the use of a subsequent EUTM not only on the date of filing or priority of that mark but **also on the date on which the EUIPO takes a decision on the invalidity** (§ 30)

2 Absolute grounds

Contrary to public policy (Article 7(1)(f) EUTMR)

Case references : T-178/20 BavariaWeed (fig.)

*

EUTM



Therapeutic use of cannabis

Classes 35, 39, 42, 44

 application rejected

 Contested decision confirmed

Bavaria weed

T-178/20

- The sign promotes and trivializes the use of marijuana as a prohibited and illegal substance (§ 42)
- That prohibition seeks to protect a **fundamental interest** in accordance with MS systems of value
- The rules applicable to the consumption and use of that substance are a matter of **public policy** for the purposes of Article 7(1)(f) EUTMR
- Articles 83 and 168 (1) TFEU



Contrary to accepted principles of morality – Article 7(1)(f) EUTMR

Case reference: R 459/2020-5

EUTM



Classes 14, 18, 25 and 35

 EUTM declared invalid



Appeal dismissed
Contested decision confirmed

BOY LONDON (fig.)

R 459/2020-5

- Reference to Nazi ideology which is **contrary to the fundamental values of the European Union**
- The mark is of such a nature as **to shock or offend** not only the victims of the Nazi regime, but also anyone in the territory of the European Union who faces that trade mark and has a normal degree of sensitivity and tolerance
- Cancellation of the mark **does not constitute a violation of freedom of expression**
- Cultural expression of the British underground culture is not an excuse to maintain the mark on the Register



Article 7(1)(b) and (c) EUTMR

Case reference: T-481/20

*

EUTM

CoolTUBE

- The argument drawn from the **multiple meanings** of the sign can be validly made by the applicant in the context of Art. 7 (1) (b) EUTMR (§ 37)
- Sign evokes two meanings which **differ significantly** from one another, ambivalent message, surprising and unexpected play on words, easy to memorise (§ 40)

Cl. 6, 9 and 17

 **Contested decision annulled**

 **TM registered**

3 Relative grounds

Reputation - Article 8(5) EUTMR

Case reference :T-510/19

EUTM applied for

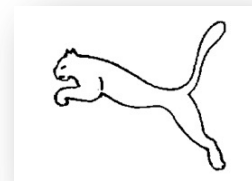


Cl. 7: Machines for processing of wood, processing aluminium, treatment of PVC



TM registered

Prior rights



Cl. 18, 25, 28



Opposition rejected

DEVICE OF A JUMPING ANIMAL (fig.) / PUMA (fig.) et al

T-510/19

- ❑ Claim of **exceptional reputation** inadmissible - relied on for the first time before GC (§ 81).
- ❑ Argument that with the i) **extraordinarily high reputation** of the earlier marks and ii) the marks at issue being **practically identical**, the risk of detriment or of unfair advantage is so obvious that there is no need to put forward evidence rejected - **premise incorrect**.
- ❑ Opponent has to prove that there is a serious risk that one of the types of injury referred to in Article 8(5) will occur.



Reputation – Article 8(5) EUTMR

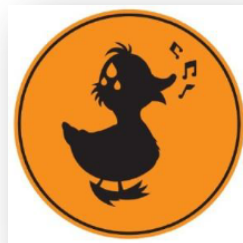
Case reference: R 997/2020-5

EUTM application



Cl. 18 and 25

Earlier mark



Cl. 18, 25, 28

✗ Application rejected

✓ Opposition allowed

ITINERANT (fig.) / RAPPRESENTAZIONE DI UN PAPERINO CANTANDO (fig.) et al.

R 997/2020-5

- Reputation of the earlier mark in Italy
- In view of similarity between the marks and proximity of the goods concerned a **link will be established**
- Situation may arise where the applicant is allowed to **'free-ride'** on the investment of the opponent in promoting and building up goodwill for its earlier mark
- No due cause** demonstrated by the applicant



Article 8(1) (b) EUTMR – Likelihood of confusion

Case reference :T-368/20

EUTM applied for

MILEY CYRUS

Cl. 9,
16, 28 and 41

TM registered

Prior rights

The logo for 'CYRUS' is displayed in a stylized, black, sans-serif font. The letters 'C', 'Y', and 'R' are connected, and the 'S' is also connected to the 'R'. The logo is centered within a white rectangular box that has a subtle drop shadow.

Cl. 9 and 20

Opposition rejected.

Right to a name – Article 60(2)(a) EUTMR

Case reference: R 1940/2020-5

EUTM

GUSTAVE EIFFEL

Classes 3, 6, 7, 8, 9, 12, 14,
16, 17, 18, 20, 21, 24, 25, 26,
28, 33, 34, 38, 39, 42, and 43

✗ EUTM declared invalid

Prior right

Gustave Eiffel

✓ Appeal dismissed

GUSTAVE EIFFEL (fig.) / GUSTAVE EIFFEL

R 1940/2020-5

- Right to a name under French law
- Article 60(2)(a) EUTMR requires the application of national law which includes also relevant national case-law
- Intention to **commercially exploit the sign** for a large range of goods and services
- Compatibility of commercial use with the **defence of the right to a surname**

Conflict with PDO – Article 8(6) in conjunction with Article 103(2)(b) of Regulation (EU) No 1308/2013)

Case reference: R 885/2020-1

EUTM applied for

Es Valentía

'wine with the designation
of origin Utiel-Requena;
cava' in Class 33

**Prior rights:
PDO 'Valencia' and EU Collective TM**



'wines with registered
designation of origin
'Valencia' in Class 33

✗ Application rejected



**Decision annulled
Opposition allowed**

Es Valentía / VALENCIA DENOMINACIÓN DE ORIGEN et al.

R 885/2020-1

- Concept of ‘**evocation**’ within the meaning of Article 103(2)(b) of Regulation (EU) No 1308/2013
- Contested sign will evoke the PDO ‘Valencia’** in the minds of part of the Spanish-speaking and non-Spanish-speaking consumers in the EU
- Conceptual proximity**, since ‘VALENTIA’ is the old name of the city of Valencia

Unauthorised filing by an agent – Article 8(3) EUTMR in conjunction with Article 59(1)(a) EUTMR

Case reference: R 1523/2020-1

EUTM

ECONOMIC PARFEMI

Cl. 3, 16 and 35

Prior rights


Economic

Cl. 3

✗ EUTM partially declared invalid

**✓ Decision partially annulled
Cancellation partially upheld**

ECONOMIC PARFEMI / Economic (fig.) et al.

R 1523/2020-1

- A mere purchaser or customer cannot be considered as an 'agent' or 'representative'
- However, the condition can be met if there existed **frequent commercial transactions** between the parties before the filing of the EUTM
- Article 8(3) EUTMR can apply in case the marks are not strictly identical, but **similar**
- Goods and services must be similar or **'equivalent in commercial terms'**



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Reallocation of a case to the Grand Board - EUIPO OJ 01/06/2021

R 0723/2021-G, 'IT'S LIKE MILK BUT MADE FOR HUMANS'

Written observations may be submitted within two months following the EUIPO OJ publication by groups or bodies representing manufacturers, producers, suppliers of services, traders or consumers which can establish an interest in the result of a case on appeal brought before the Grand Board (Article 37(6) EUTMDR).

**IT'S LIKE
MILK, BUT
MADE FOR
HUMANS.**



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Recent GC/CJ judgments

Overview of GC/CJ case law 2019 – 2021

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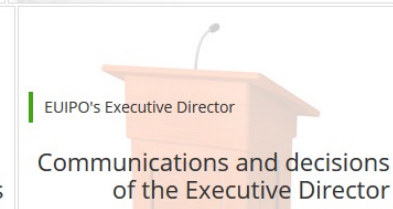
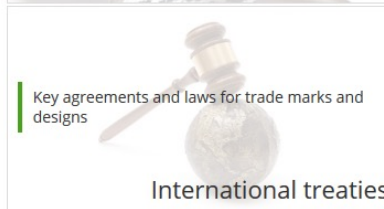


Law

In this section you will find the law relating to the European Union trade mark (EUTM) and the registered Community design (RCD), as well as to key international agreements.

You will also find our Executive Director's decisions and communications, along with the rules concerning the Boards of Appeal.

In this section



Law

- ▶ [EU trade mark legal texts](#)
- ▶ [Community design legal texts](#)
- ▶ [International treaties](#)
- ▶ [Brexit](#)
- ▶ [Decisions & Communications of the Executive Director](#)
- ▶ [Presidium of the Boards of Appeal](#)
- ▶ [Official Journal](#)

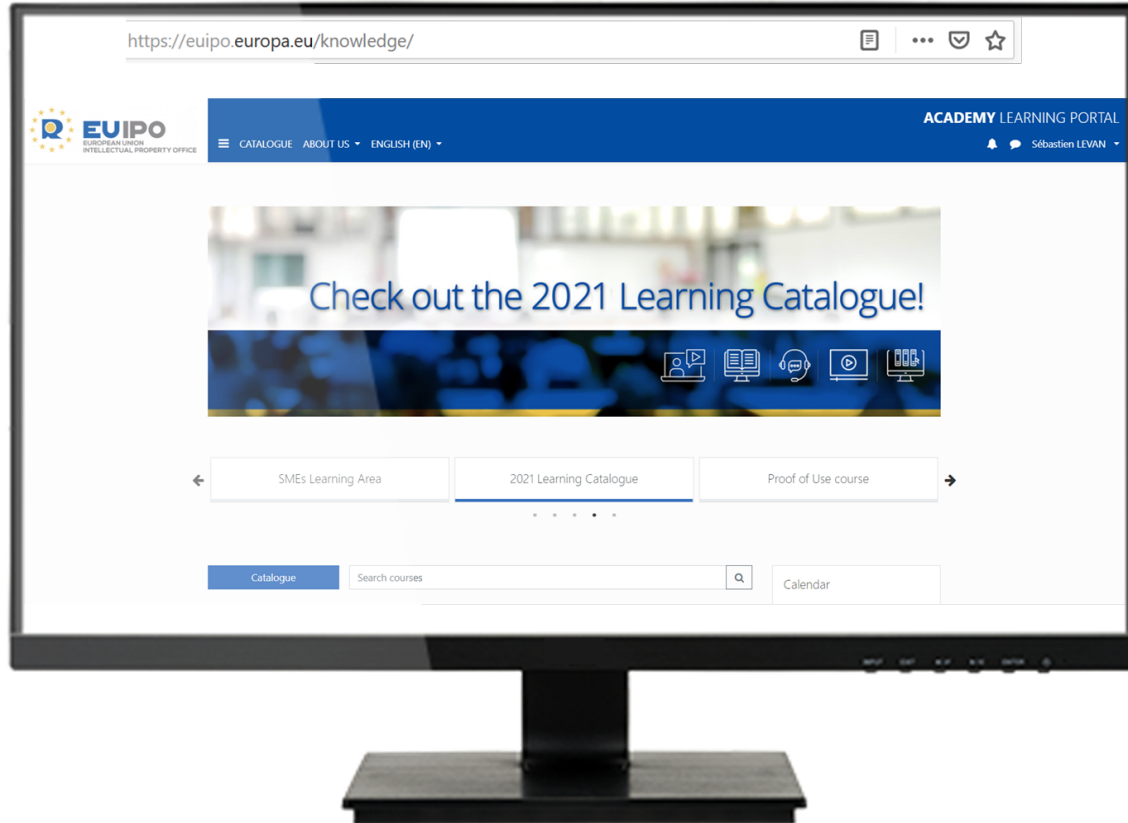
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